

Applicant/Patentee: Geoffrey M. WAHL et al.

Docket No.: 366482000300

Serial No./Patent No.: 09/229,229

Filed on/Issued: January 12, 1999

For COMPOSITIONS AND METHODS FOR TREATING CELLS HAVING DOUBLE MINUTE DNA

**VERIFIED STATEMENT CLAIMING SMALL ENTITY
STATUS 37 C.F.R. § 1.9(f) AND § 1.27(d) - NONPROFIT ORGANIZATION**

I hereby declare that I am an official empowered to act on behalf of the non-profit organization identified below:

Name of nonprofit organization: The Salk Institute

Address of nonprofit organization: 10010 North Torrey Pines Road, San Diego, CA 92037

Type of nonprofit organization:

- University or other institution of higher education
 Tax exempt under Internal Revenue Service Code (26 U.S.C. §§ 501(a) and 501(c)(3))
 Nonprofit scientific or educational under a statute of a state of the United States of America

Name of state:

Citation of statute:

- Would qualify as tax exempt under Internal Revenue Service Code (26 U.S.C. §§ 501(a) and 501(c)(3)) if located in the United States of America
 Would qualify as nonprofit scientific or educational organization under a statute of a state of the United States of America if located in the United States of America

Name of state:

Citation of statute:

I hereby declare that the nonprofit organization identified above qualifies as a nonprofit organization as defined in 37 C.F.R. § 1.9(e) for purposes of paying reduced fees to the United States Patent and Trademark Office regarding the invention entitled COMPOSITIONS AND METHODS FOR TREATING CELLS HAVING DOUBLE MINUTE DNA by inventor(s) Geoffrey M. Wahl, Noriaki Shimizu, Teru Kanda, and H. Michael Shepard described in:

- the specification filed herewith.
 application serial no. 09/229,229, filed January 12, 1999.
 patent no. , issued.

I hereby declare that the rights under contract or law have been conveyed to and remain with the nonprofit organization regarding the above identified invention. If the rights held by the nonprofit organization are not exclusive, each individual, concern or organization having rights in the invention must file separate verified statements answering to their status as small entities ant that no rights to the invention are held by any person other than the inventor, who would not qualify as an independent inventor under 37 C.F.R. § 1.9(c) if that person made the invention, or by any concern which would not qualify as a small business concern under 37 C.F.R. § 1.9(d) or a non-profit organization uder 37 § 1.9(e).

Each person, concern or organization having any rights in the invention is listed below:

- no such person, concern or organization exists.
 each such person, concern or organization is listed below.

| NAME | ADDRESS | TYPE |
|------------------|--|--|
| NewBiotics, Inc. | 11760 Sorrento Valley Road, Suite R San Diego, CA 92121 | <input type="checkbox"/> Individual <input checked="" type="checkbox"/> Small Business Concern <input type="checkbox"/> Nonprofit Organization |

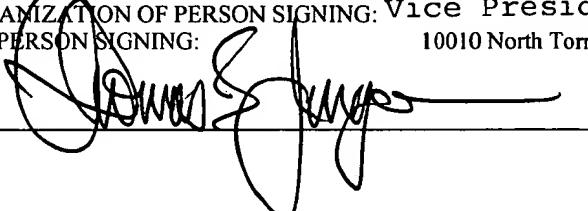
I acknowledge the duty to file, in this application or patent, notification or any change in status resulting in loss of entitlement to small entity status prior to paying, or at the time of paying, the earliest of the issue fee or any maintenance fee due after the date on which status as a small entity is no longer appropriate (37 C.F.R. § 1.28(b)).

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application, any patent issuing thereon, or any patent to which this verified statement is directed.

NAME OF PERSON SIGNING: Thomas E. Jurgensen

TITLE IN ORGANIZATION OF PERSON SIGNING: Vice President , IP & Technology Transfer

ADDRESS OF PERSON SIGNING: 10010 North Torrey Pines Road, San Diego, CA 92037

SIGNATURE: 

DATE: 9/4/99

Applicant/Patentee: Geoffrey M. WAHL et al.

Docket No.: 366482000300

Serial No./Patent No.: 09/229,229

Filed on/Issued : January 12, 1999

For: COMPOSITIONS AND METHODS FOR TREATING CELLS HAVING DOUBLE MINUTE DNA

**VERIFIED STATEMENT CLAIMING SMALL ENTITY STATUS
37 C.F.R. §§ 1.9(f) AND 1.27(c) — SMALL BUSINESS CONCERN**

O I P E
APR 15 1999

PATENT & TRADEMARK OFFICE
97

I hereby declare that I am

- the owner of the small business concern identified below:
 an official of the small business concern empowered to act on behalf of the concern identified below:

NAME OF CONCERN: NewBiotics, Inc.

ADDRESS OF CONCERN: 11760 Sorrento Valley Road, Suite R, San Diego, CA 92121

I hereby declare that the above identified small business concern qualifies as a small business concern as defined in 13 C.F.R. § 121.12, and reproduced in 37 C.F.R. § 1.9(d), for purposes of paying reduced fees to the United States Patent and Trademark Office, in that the number of employees of the concern, including those of its affiliates, does not exceed 500 persons. For purposes of this statement, (1) the number of employees of the business concern is the average over the previous fiscal year of the concern of the persons employed on a full-time, part-time or temporary basis during each of the pay periods of the fiscal year, and (2) concerns are affiliates of each other when either, directly or indirectly, one concern controls or has the power to control the other, or a third party or parties controls or has the power to control both.

I hereby declare that rights under contract or law have been conveyed to and remain with the small business concern identified above with regard to the invention, entitled COMPOSITIONS AND METHODS FOR TREATING CELLS HAVING DOUBLE MINUTE DNA by inventor(s) Geoffrey M. Wahl, Noriaki Shimizu, Teru Kanda, and H. Michael Shepard described in

- the specification filed herewith with title as listed above.
 the application identified above.
 the patent identified above.

If the rights held by the above identified business concern are not exclusive, each individual, concern or organization having rights in the invention must file separate verified statements averring to their status as small entities, and no rights to the invention are held by any person, other than the inventor, who would not qualify as an independent inventor under 37 C.F.R. § 1.9(c) if that person made the invention, or by any concern which would not qualify as a small business concern under 37 C.F.R. § 1.9(d), or a nonprofit organization under 37 C.F.R. § 1.9(e).

Each person, concern or organization having any rights in the invention is listed below:

- no such person, concern, or organization exists.
 each such person, concern or organization is listed below.

| NAME | ADDRESS | TYPE |
|--------------------|---|--|
| The Salk Institute | 10010 North Torrey Pines Road La Jolla, CA 92037 | <input type="checkbox"/> Individual <input type="checkbox"/> Small Business Concern <input checked="" type="checkbox"/> Nonprofit Organization |

Separate verified statements are required from each named person, concern or organization having rights to the invention averring to their status as small entities. (37 C.F.R. § 1.27)

I acknowledge the duty to file, in this application or patent, notification or any change in status resulting in loss of entitlement to small entity status prior to paying, or at the time of paying, the earliest of the issue fee or any maintenance fee due after the date on which status as a small entity is no longer appropriate. (37 C.F.R. § 1.28(b))

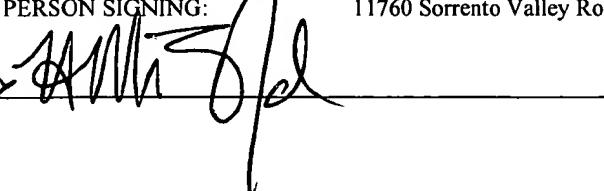
I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application, any patent issuing thereon, or any patent to which this verified statement is directed.

NAME OF PERSON SIGNING:

TITLE OF PERSON IF OTHER THAN OWNER:

ADDRESS OF PERSON SIGNING:

11760 Sorrento Valley Road, Suite R, San Diego, CA 92121

SIGNATURE: 

DATE: 3/19/99



PATENT
Docket No. 366482000300

#4

DECLARATION FOR UTILITY PATENT APPLICATION

AS A BELOW-NAMED INVENTOR, I HEREBY DECLARE THAT:

My residence, post office address, and citizenship are as stated below next to my name.

I believe I am the original, first and joint inventor of the subject matter which is claimed and for which a patent is sought on the invention entitled: COMPOSITIONS AND METHODS FOR TREATING CELLS HAVING DOUBLE MINUTE DNA, the specification of which is attached hereto unless the following box is checked:

was filed on January 12, 1999 as United States Application Serial No. 09/229,229.

I HEREBY STATE THAT I HAVE REVIEWED AND UNDERSTAND THE CONTENTS OF THE ABOVE-IDENTIFIED SPECIFICATION, INCLUDING THE CLAIMS, AS AMENDED BY ANY AMENDMENT REFERRED TO ABOVE.

I acknowledge the duty to disclose information which is material to the patentability as defined in 37 C.F.R. § 1.56.

I hereby claim foreign priority benefits under 35 U.S.C. § 119(a)-(d) or § 365(b) of any foreign application(s) for patent or inventor's certificate, or § 365(a) of any PCT International application which designated at least one country other than the United States listed below and have also identified below, by checking the box, any foreign application for patent or inventor's certificate, or PCT International application having a filing date before that of the application on which priority is claimed:

| Application No. | Country | Date of Filing (day/month/year) | Priority Claimed? |
|-----------------|---------|------------------------------------|--|
| | | | <input type="checkbox"/> Yes <input type="checkbox"/> No |

I hereby claim benefit under 35 U.S.C. § 119(e) of any United States provisional application(s) listed below:

| Application Serial No. | Filing Date |
|------------------------|-------------|
| 60/071,146 | 01/12/98 |
| 60/077,644 | 03/11/98 |

I hereby claim the benefit under 35 U.S.C. § 120 of any United States application(s), or § 365(c) of any PCT International application designating the United States, listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States or PCT International application in the manner provided by the first paragraph of 35 U.S.C. § 112, I acknowledge the duty to disclose information which is material to patentability as defined in 37 C.F.R. § 1.56 which became available between the filing date of the prior application and the national or PCT International filing date of this application.

| Application Serial No. | Filing Date | Status |
|------------------------|-------------|---|
| | | <input type="checkbox"/> Patented <input type="checkbox"/> Pending <input type="checkbox"/> Abandoned |

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under § 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

3-3-99

Date



Name: Geoffrey M. WAHL

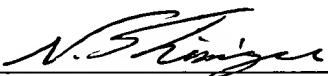
Residence: San Diego, California

Citizenship: U.S.A.

Post Office Address: 4528 Arquello Street, San Diego, CA 92103

3-16-99

Date



Name: Noriaki SHIMIZU

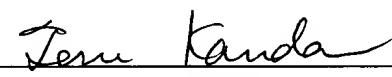
Residence: Hiroshima, Japan

Citizenship: Japan

Post Office Address: 1663-8, Hatihonmatu, Hiroshima, Japan

3-3-99

Date



Name: Teru KANDA

Residence: La Jolla, California

Citizenship: ~~USA~~ Japan (T.K.)

Post Office Address: 8526 Villa La Jolla #128, La Jolla, CA 92037

Date

Name: H. Michael SHEPARD

Residence: Rancho Santa Fe, California

Citizenship: U.S.A.

Post Office Address: 16825 Via de Santa Fe, Rancho Santa Fe, CA 92067



PATENT
Docket No. 366482000300

DECLARATION FOR UTILITY PATENT APPLICATION

AS A BELOW-NAMED INVENTOR, I HEREBY DECLARE THAT:

My residence, post office address, and citizenship are as stated below next to my name.

I believe I am the original, first and joint inventor of the subject matter which is claimed and for which a patent is sought on the invention entitled: COMPOSITIONS AND METHODS FOR TREATING CELLS HAVING DOUBLE MINUTE DNA, the specification of which is attached hereto unless the following box is checked:

was filed on January 12, 1999 as United States Application Serial No. 09/229,229.

I HEREBY STATE THAT I HAVE REVIEWED AND UNDERSTAND THE CONTENTS OF THE ABOVE-IDENTIFIED SPECIFICATION, INCLUDING THE CLAIMS, AS AMENDED BY ANY AMENDMENT REFERRED TO ABOVE.

I acknowledge the duty to disclose information which is material to the patentability as defined in 37 C.F.R. § 1.56.

I hereby claim foreign priority benefits under 35 U.S.C. § 119(a)-(d) or § 365(b) of any foreign application(s) for patent or inventor's certificate, or § 365(a) of any PCT International application which designated at least one country other than the United States listed below and have also identified below, by checking the box, any foreign application for patent or inventor's certificate, or PCT International application having a filing date before that of the application on which priority is claimed:

| Application No. | Country | Date of Filing (day/month/year) | Priority Claimed? |
|-----------------|---------|------------------------------------|--|
| | | | <input type="checkbox"/> Yes <input type="checkbox"/> No |

I hereby claim benefit under 35 U.S.C. § 119(e) of any United States provisional application(s) listed below:

| Application Serial No. | Filing Date |
|------------------------|-------------|
| 60/071,146 | 01/12/98 |
| 60/077,644 | 03/11/98 |

I hereby claim the benefit under 35 U.S.C. § 120 of any United States application(s), or § 365(c) of any PCT International application designating the United States, listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States or PCT International application in the manner provided by the first paragraph of 35 U.S.C. § 112, I acknowledge the duty to disclose information which is material to patentability as defined in 37 C.F.R. § 1.56 which became available between the filing date of the prior application and the national or PCT International filing date of this application.

| Application Serial No. | Filing Date | Status |
|------------------------|-------------|---|
| | | <input type="checkbox"/> Patented <input type="checkbox"/> Pending <input type="checkbox"/> Abandoned |

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under § 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

| | | |
|------|----------------------|---|
| Date | Name: | Geoffrey M. WAHL |
| | Residence: | San Diego, California |
| | Citizenship: | U.S.A. |
| | Post Office Address: | 4528 Arquello Street, San Diego, CA 92103 |

| | | |
|------|----------------------|---------------------------------------|
| Date | Name: | Noriaki SHIMIZU |
| | Residence: | Hiroshima, Japan |
| | Citizenship: | Japan |
| | Post Office Address: | 1663-8, Hatihonmatu, Hiroshima, Japan |

| | | |
|------|----------------------|--|
| Date | Name: | Teru KANDA |
| | Residence: | La Jolla, California |
| | Citizenship: | U.S.A. |
| | Post Office Address: | 8526 Villa La Jolla #128, La Jolla, CA 92037 |

3/9/99

| | |
|----------------------|--|
| Name: | H. Michael SHEPARD |
| Residence: | Rancho Santa Fe, California |
| Citizenship: | U.S.A. |
| Post Office Address: | 16825 Via de Santa Fe, Rancho Santa Fe, CA 92067 |

ASSIGNMENT
SOLE

COPY

THIS ASSIGNMENT, by H. Michael Shepard (hereinafter referred to as the assignor), residing at 16825 Via de la Fe, Rancho Santa Fe, CA 92067, respectively, witnesseth:

WHEREAS, said assignor has invented certain new and useful improvements in COMPOSITIONS AND METHODS FOR TREATING CELLS HAVING DOUBLE MINUTE DNA, set forth in an application for Letters Patent in the United States, bearing Serial No. 09/229,229 and filed on January 12, 1999; and

WHEREAS, NewBiotics, Inc., a corporation duly organized under and pursuant to the laws of California and having its principal place of business at 11760 Sorrento Valley Road, San Diego, CA 92121 is desirous of acquiring the entire right, title and interest in and to said inventions and said application for Letters Patent of the United States, and in regard to any Letters Patent or Patents, United States or foreign, to be obtained therefor and thereon;

NOW, THEREFORE, in consideration of One Dollar (\$1.00) and other good and sufficient consideration, the receipt of which is hereby acknowledged, said assignor have sold, assigned, transferred and set over, and by these presents does sell, assign, transfer and set over, unto said assignee, its successors, legal representatives and assigns, the entire right, title and interest in and to the above-mentioned inventions, application for Letters Patent, and any and all Letters Patent or Patents in the United States of America and all foreign countries which may be granted therefor and thereon, and in and to any and all divisions, continuations and continuations-in-part of said application, or reissues or extensions of said Letters Patent or Patents, and all rights under the International Convention for the Protection of Industrial Property, the same to be held and enjoyed by said assignee, for its own use and the use of its successors, legal representatives and assigns, to the full end of the term or terms for which Letters Patent or Patents may be granted, as fully and entirely as the same would have been held and enjoyed by the assignor, had this sale and assignment not been made.

AND for the same consideration, said assignor hereby covenant and agree to and with said assignee its successors, legal representatives and assigns, that, at the time of execution and delivery of these presents, said assignor are the sole and lawful owners of the entire right, title and interest in and to said inventions and the application for Letters Patent above-mentioned, and that the same are unencumbered and that said assignor have good and full right and lawful authority to sell and convey the same in the manner herein set forth.

AND for the same consideration, said assignor hereby covenant and agree to and with said assignee, its successors, legal representatives and assigns, that said assignor will, whenever counsel of said assignee, or the counsel of its successors, legal representatives and assigns, shall advise that any proceeding in connection with said inventions, or said application for Letters Patent, or any proceeding in connection with Letters Patent for said inventions in any country, including interference proceedings, is lawful and desirable, or that any division, continuation or continuation-in-part of any application for Letters Patent or any reissue or extension of any Letters Patent, to be obtained thereon, is lawful and desirable, sign all papers and documents, take all lawful oaths, and do all acts necessary or required to be done for the procurement, maintenance, enforcement and defense of Letters Patent for said inventions, without charge to said assignee, its successors, legal representatives and assigns, but at the cost and expense of said assignee, its successors, legal representatives and assigns.

AND said assignor hereby request the Commissioner of Patents to issue said Letters Patent of the United States to said assignee as the assignee of said inventions and the Letters Patent to be issued thereon for the sole use of said assignee, its successors, legal representatives and assigns.

3/2/99
Date

H. Michael SHEPARD

ASSIGNMENT
JOINT

COPY

THIS ASSIGNMENT, by Geoffrey M. Wahl, Noriaki Shimizu, and Teru Kanda (hereinafter referred to as the assignors), residing at 4528 Arquello Street, San Diego, CA 92103; 1663-8, Hatihonmatu, Hiroshima, Japan; and 8526 Villa La Jolla #128, La Jolla, CA 92037, respectively, witnesseth:

WHEREAS, said assignors has invented certain new and useful improvements in COMPOSITIONS AND METHODS FOR TREATING CELLS HAVING DOUBLE MINUTE DNA, set forth in an application for Letters Patent of the United States, bearing Serial No. 09/229,229 and filed on January 12, 1999; and

WHEREAS, The Salk Institute, a non-profit scientific organization and having a principal place of business at 10010 North Torrey Pines Road, San Diego, CA 92037 is desirous of acquiring the entire right, title and interest in and to said inventions and said application for Letters Patent of the United States, and in and to any Letters Patent or Patents, United States or foreign, to be obtained therefor and thereon:

NOW, THEREFORE, in consideration of One Dollar (\$1.00) and other good and sufficient consideration, the receipt of which is hereby acknowledged, said assignors have sold, assigned, transferred and set over, and by these presents does sell, assign, transfer and set over, unto said assignee, its successors, legal representatives and assigns, the entire right, title and interest in and to the above-mentioned inventions, application for Letters Patent, and any and all Letters Patent or Patents in the United States of America and all foreign countries which may be granted therefor and thereon, and in and to any and all divisions, continuations and continuations-in-part of said application, or reissues or extensions of said Letters Patent or Patents, and all rights under the International Convention for the Protection of Industrial Property, the same to be held and enjoyed by said assignee, for its own use and the use of its successors, legal representatives and assigns, to the full end of the term or terms for which Letters Patent or Patents may be granted, as fully and entirely as the same would have been held and enjoyed by the assignors, had this sale and assignment not been made.

AND for the same consideration, said assignors hereby covenant and agree to and with said assignee its successors, legal representatives and assigns, that, at the time of execution and delivery of these presents, said assignors are the sole and lawful owners of the entire right, title and interest in and to said inventions and the application for Letters Patent above-mentioned, and that the same are unencumbered and that said assignors have good and full right and lawful authority to sell and convey the same in the manner herein set forth.

AND for the same consideration, said assignors hereby covenant and agree to and with said assignee, its successors, legal representatives and assigns, that said assignors will, whenever counsel of said assignee, or the counsel of its successors, legal representatives and assigns, shall advise that any proceeding in connection with said inventions, or said application for Letters Patent, or any proceeding in connection with Letters Patent for said inventions in any country, including interference proceedings, is lawful and desirable, or that any division, continuation or continuation-in-part of any application for Letters Patent or any reissue or extension of any Letters Patent, to be obtained thereon, is lawful and desirable, sign all papers and documents, take all lawful oaths, and do all acts necessary or required to be done for the procurement, maintenance, enforcement and defense of Letters Patent for said inventions, without charge to said assignee, its successors, legal representatives and assigns, but at the cost and expense of said assignee, its successors, legal representatives and assigns.

AND said assignors hereby request the Commissioner of Patents to issue said Letters Patent of the United States to said assignee as the assignee of said inventions and the Letters Patent to be issued thereon for the sole use of said assignee, its successors, legal representatives and assigns.

3-3-99

Date

3-16-99

Date

3-3-99

Date

Geoffrey M. Wahl

Geoffrey M. Wahl

Noriaki Shimizu

N. Shimizu

Teru Kanda

Teru Kanda